

JUL 17 2008

PTO/SB/21 (11-07)

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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

7

Application Number

10/582,233

Filing Date

June 9, 2006

First Named Inventor

Yulin HAO

Art Unit

1793

Examiner Name

George P. Wyszomierski

Attorney Docket Number

033792R005

## ENCLOSURES (Check all that apply)

☐

Fee Transmittal Form

☐

Fee Attached

☒

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

☐

Information Disclosure Statement

☐

Certified Copy of Priority Document(s)

☐

Reply to Missing Parts/Incomplete Application

☐

Reply to Missing Parts under 37 CFR 1.52 or 1.53

☐

Drawing(s)

☐

Licensing-related Papers

☐

Petition

☐

Petition to Convert to a Provisional Application

☐

Power of Attorney, Revocation

☐

Change of Correspondence Address

☐

Terminal Disclaimer

☐

Request for Refund

☐

CD, Number of CD(s) \_\_\_\_\_

Landscape Table on CD

☐

After Allowance Communication to TC

☐

Appeal Communication to Board of Appeals and Interferences

☐

Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)

☐

Proprietary Information

☐

Status Letter

☒

Other Enclosure(s) (please identify below):

Copy of English language translation of International Preliminary Report on Patentability submitted with Response to Restriction Requirement

Remarks

Response to Restriction Requirement - Office Action dated June 17, 2008

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Smith, Gambrell & Russell

Signature

Printed name

Dennis C. Rodgers

Date

July 17, 2008

Reg. No.

32,936

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name

Date

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Yulin Hao, et al. Confirmation No.: 2857  
U.S. Serial No. : 10/582,233  
Filed : June 9, 2006  
Examiner : George P. Wyszomierski  
Group Art Unit : 1793  
For : TITANIUM ALLOY WITH EXTRA-LOW MODULUS AND  
SUPERELASTICITY AND IT'S PRODUCING METHOD AND  
PROCESSING THEROF

**RESPONSE TO WRITTEN RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir :

This is in reply to the Office Action dated June 17, 2008, to which the time for response is set to expire July 17, 2008. The Office Action provides the following restriction requirement:

Group I, claims 1-5 and 14-20, drawn to an alloy

Group II, claims 6-13, drawn to a method

Applicants elect Group 1 for prosecution on the merits with at least claims 1-5 and 14-20 being directed at the elected group. Applicants respectfully reserve the right to request rejoinder of the non-elected method claims, once the subject matter of the elected product claims are deemed to be in condition for allowance.

Also, for additional reference, Applicants enclose a copy of the English language translation of the "International Preliminary Report on Patentability" wherein all claims are indicated as being novel and to involve inventive step over the art of record (including the

category "A" reference utilized in the Examiner's Restriction Requirement). It is respectfully requested that the Examiner consider this in determining the appropriateness of the restriction imposition.

If any fees under 37 CFR §§1.16 or 1.17 are due in this filing, please charge the fees to Deposit Account No. 02-4300; Order No. 033792.005. If an extension of time under 37 CFR §1.136 is necessary and not included herewith, such an extension is requested. The extension fee should be charged to Deposit Account No. 02-4300; Order No. 033792 R 005.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

By:



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Dennis C. Rodgers, Reg. No. 32,936  
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Facsimile: 202/263-4329

Date: July 17, 2008

DCR/TBP/lhb

From the INTERNATIONAL BUREAU

**PCT**

NOTIFICATION OF TRANSMITTAL  
OF COPIES OF TRANSLATION  
OF THE INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY  
(CHAPTER I OR CHAPTER II  
OF THE PATENT COOPERATION TREATY)  
(PCT Rules 44bis.3(c) and 72.2)

To:

SHENYANG PATENT & TRADEMARK AGENCY  
ACADEMIA SINICA  
24 Sanhao Street  
Heping District  
Shenyang  
Liaoning 110004  
CHINE

Date of mailing (day/month/year) 29 June 2006 (29.06.2006)	
Applicant's or agent's file reference IP04010	IMPORTANT NOTIFICATION
International application No. PCT/CN2004/001352	International filing date (day/month/year) 25 November 2004 (25.11.2004)
Applicant INSTITUTE OF METAL RESEARCH CHINESE ACADEMY OF SCIENCES et al	

**1. Transmittal of the translation to the applicant.**☐

The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).

☒

The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

**2. Transmittal of the copy of the translation to the designated or elected Offices.**

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

EP, KR

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EA, EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

**3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).**

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Authorized officer  Nora Lindner
Facsimile No. +41 22 740 14 35	Facsimile No. +41 22 338 89 65

translation

PATENT COOPERATION TREATY

PCT



INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY  
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference. IP04010		FOR FURTHER ACTION	See Form PCT/IPEA/416
International application No. PCT/CN2004/001352	International filing date (day/month/year) 25.Nov.2004 (25.11.2004)	Priority date (day/month/year) 25.Dec.2003 (25.12.2003)	
International Patent Classification (IPC) or national classification and IPC IPC <sup>7</sup> : C22C14/00			
Applicant INSTITUTE OF METAL RESEARCH CHINESE ACADEMY OF SCIENCES et al.			
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>3</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input checked="" type="checkbox"/> (sent to the applicant and to the International Bureau) a total of <u>2</u> sheets, as follows:</p> <p><input checked="" type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic _____, containing a sequence listing and/or tables related thereto, in electronic form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>			
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the report</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>			
Date of submission of the demand 08.May 2005 (08.05.2005)		Date of completion of this report 12.Dec.2005 (12.12.2005)	
Name and mailing address of the IPEA/CN The State Intellectual Property Office, the P.R.China, 6 Xitucheng Rd., Jimen Bridge, Haidian District, Beijing, China 100088		Authorized officer PANG Limin	
Facsimile No. 86-10-62019451		Telephone No. (86-10) 62084726	

# INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.  
PCT/CN2004/001352

## Box No. I Basis of the report

1. With regard to the language, this report is based on:

- ☒ the international application in the language in which it was filed
- ☐ a translation of the international application into \_\_\_\_\_, which is the language of a translation furnished for the purposes of:
- ☐ international search (Rules 12.3(a) and 23.1(b))
- ☐ publication of the international application (Rule 12.4(a))
- ☐ international preliminary examination (Rules 55.2(a) and/or 55.3(a))

2. With regard to the elements of the international application, this report is based on (*replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report*):

- ☐ the international application as originally filed/furnished
- ☒ the description:
- |         |         |   |
|---------|---------|---|
| pages   | 1, 3-13 | as originally filed/furnished                         |
| pages * | 2       | received by this Authority on 08.May2005 (08.05.2005) |
| pages * |         | received by this Authority on                         |
- ☒ the claims:
- |         |   |   |
|---------|---|---|
| pages   |   | as originally filed/furnished                             |
| pages * |   | as amended (together with any statement) under Article 19 |
| pages * | 1 | received by this Authority on 08.May2005 (08.05.2005)     |
| pages * |   | received by this Authority on                             |
- ☒ the drawings:
- |         |     |                               |
|---------|-----|-------------------------------|
| pages   | 1-8 | as originally filed/furnished |
| pages * |     | received by this Authority on |
| pages * |     | received by this Authority on |

☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.

3. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (*specify*): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (*specify*): \_\_\_\_\_

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (*specify*): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (*specify*): \_\_\_\_\_

\* If item 4 applies, some or all of those sheets may be marked "superseded."

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.  
PCT/CN2004/001352**Box No. V** Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;  
citations and explanations supporting such statement

## 1. Statement:

Novelty (N)	Claims 1-13	YES
	Claims	NO
Inventive step (IS)	Claims 1-13	YES
	Claims	NO
Industrial applicability (IA)	Claims 1-13	YES
	Claims	NO

## 2. Citations and explanations (Rule 70.7)

None of the subject matters of claims 1-13 has been anticipated in the prior art. So claims 1-13 appear to be novel according to Art.33(2) PCT.

None of the subject matters of claims 1-13 could be obtained plainly or logically from the prior art, and they are not obvious to the skilled in the art. Therefore, in view of the documents cited in the Search Report, the subject matters of claims 1-13 appear to involve inventive step according to the Art. 33(3) PCT.

Claims 1-13 can be made or used according to their nature and are therefore industrially applicable according to Art.33(4) PCT.